



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,487	02/23/2004	Yasuo Hashimoto	81864.0029	1786

26021 7590 07/12/2005

HOGAN & HARTSON L.L.P.
500 S. GRAND AVENUE
SUITE 1900
LOS ANGELES, CA 90071-2611

EXAMINER

BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
----------	--------------

1773

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/785,487	Applicant(s) HASHIMOTO ET AL.	
	Examiner Kevin M. Bernatz	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
 4a) Of the above claim(s) 1-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/28/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, species v in the reply filed on April 25, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 15 and 16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 25, 2005.

The Examiner notes that applicants appear to have only indicated the claims included in the elected Group and have not positively indication which claims are readable on the elected specie, per the election requirement in Paragraph 4 of the Office Action mailed March 21, 2005. The Examiner notes that claim 22 reads on the elected specie (specie v). Accordingly, claims 1 – 14 and 17 – 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected specie, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 25, 2005.

Examiner's Comments

2. The Examiner notes that the present claims recite the language "an insulating layer; a metal sublayer disposed *opposite to* said insulating layer ...", yet there is nothing recited that the metal layer is *opposite* from. For purposes of evaluating the prior art, the Examiner has interpreted the limitation "disposed opposite to" as being a typographical error and has interpreted it as reciting: "disposed on". I.e. "a metal sublayer disposed on said insulating layer; and a soft magnetic metal layer disposed on said metal sublayer ...".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Isomura et al. (U.S. Patent No. 6,255,813 B1).

Regarding claim 22, Isomura et al. disclose a soft magnetic member comprising an insulating layer (*Figures 12 and 14; element 65*), a metal sublayer disposed on said insulating layer (*Figures 12 and 14, element 75*), and a soft magnetic metal layer disposed on said metal sublayer (*Figure 12, upper part of element 71 and Figure 14, element 85*), wherein the thickness of the metal sublayer is 1000 nm (1 μ m) and the

thickness of the soft magnetic metal layer is 4000 nm (4 μ m), hence meeting applicants' required thickness limitations (*col. 12, lines 5 – 28 and col. 13, lines 1 – 16*).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chou et al. (WO 2003/021610 A1). See U.S. Patent App. No. 2004/0219328 A1, which is the U.S. equivalent of WO '610 A1.

Regarding claim 22, Chou et al. disclose a soft magnetic member comprising an insulating layer (*Figure 1; element 2*), a metal sublayer disposed on said insulating layer (*Figure 1, element 3*), and a soft magnetic metal layer disposed on said metal sublayer (*Figure 1, element 4*), wherein the thickness of the metal sublayer ranges from 33 – 277 nm and the thickness of the soft magnetic layer ranges from >0 to ~1000 nm, hence covering embodiments meeting applicants' claimed limitations (*Paragraphs 0060 – 0061 and Examples*).

Chou et al. fails to explicitly disclose an embodiment meeting both of the claimed thickness equation limitations.

However, Chou et al. teach that the thickness values of the metal sublayer and soft magnetic metal layer can be varied to effect the electroplating ability and the high

frequency characteristics of the soft magnetic film (*Paragraphs 0060 – 0061*), as well as disclosing thickness values which are coextensive with applicants' claimed ranges (*ibid and Examples*). Therefore, the Examiner deems that it would have been obvious to one having ordinary skill in the art to determine thickness values for the metal sublayer and soft magnetic metal layer meeting applicants' claimed thickness limitations by optimizing the results effective variable through routine experimentation. *In re Boesch*, 205 USPQ 215 (CCPA 1980); *In re Geisler*, 116 F. 3d 1465, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); *In re Aller*, 220 F.2d, 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Conclusion

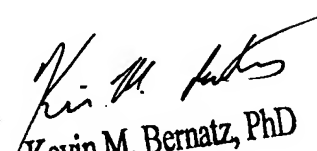
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M. Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1773

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB
July 8, 2005


Kevin M. Bernatz, PhD
Primary Examiner